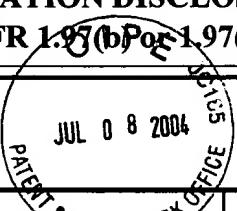


**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT  
(Under 37 CFR 1.97(b) or 1.97(c))**

Docket No.  
13095

In Re Application Of: **Robert Harris**



Serial No.  
09/938,677

Filing Date  
August 24, 2001

Examiner  
David Lukton

Group Art Unit  
1653

Title: **NEW USES FOR AMINO ACID ANTICONVULSANTS**

Address to:  
**Commissioner for Patents**  
P.O. Box 1450  
Alexandria, VA 22313-1450

**37 CFR 1.97(b)**

- The Information Disclosure Statement submitted herewith is being filed within three months of the filing of a national application other than a continued prosecution application under 37 CFR 1.53(d); within three months of the date of entry of the national stage as set forth in 37 CFR 1.491 in an international application; before the mailing of a first Office Action on the merits, or before the mailing of a first Office Action after the filing of a request for continued examination under 37 CFR 1.114.

**37 CFR 1.97(c)**

- The Information Disclosure Statement submitted herewith is being filed after the period specified in 37 CFR 1.97(b), provided that the Information Disclosure Statement is filed before the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application, and is accompanied by one of:

the statement specified in 37 CFR 1.97(e);

**OR**

the fee set forth in 37 CFR 1.17(p).

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT**  
(Under 37 CFR 1.97(b) or 1.97(c))

Docket No.  
13095

In Re Application: **Robert Harris**

Serial No.  
09/938,677

Filing Date  
August 24, 2001

Examiner  
David Lukton

Group Art Unit  
1653

**NEW USES FOR AMINO ACID ANTICONVULSANTS**

**Payment of Fee**

(Only complete if Applicant elects to pay the fee set forth in 37 CFR 1.17(p))

A check in the amount of \_\_\_\_\_ is attached.  
 The Director is hereby authorized to charge and credit Deposit Account No. **19-3886/RCT** as described below.  
 Charge the amount of \_\_\_\_\_  
 Credit any overpayment.  
 Charge any additional fee required.

**Certificate of Transmission by Facsimile\***

I certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office (F:

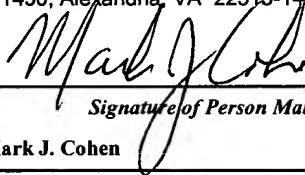
(Date)

Signature

Typed or Printed Name of Person Signing Certificate

**Certificate of Mailing by First Class Mail**

I certify that this document and fee is being deposited on **7/6/04** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Signature of Person Mailing Correspondence

Mark J. Cohen

Typed or Printed Name of Person Mailing Certificate

\*This certificate may only be used if paying by deposit account.



Signature

Mark J. Cohen

Registration No. 32,211

Scully, Scott, Murphy & Presser

400 Garden City Plaza

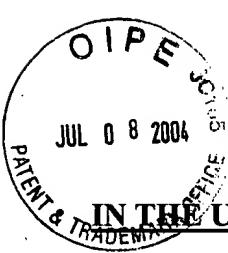
Garden City, NY 11530

(516) 742-4343

MJC:if

CC:

Dated: **July 6, 2004**



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicants:** Robert Harris

**Examiner:** David Lukton

**Serial No.:** 09/938,677

**Art Unit:** 1653

**Filed:** August 24, 2001

**Docket:** 13095

**For:** NEW USES FOR AMINO ACID  
ANTICONVULSANTS

**Dated:** July 6, 2004

**Confirmation No.:** 2566

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT**

Sir:

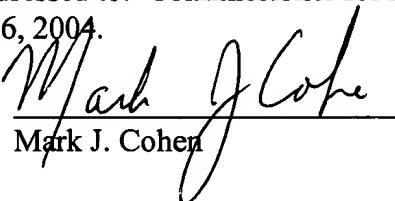
In accordance with 37 C.F.R §§1.97 and 1.98, it is requested that the following references, which are also listed on the attached Form PTO-1449, be made of record in the above-identified case.

1. United States Patent No. 5,773,475, issued June 30, 1998;
2. United States Patent No. 5,654,301, issued August 5, 1997;
3. Parsons, et al., "Modulation of NMDA receptors by glycine – introduction to some basic aspects and recent developments", Amino Acids, 14: 207-216 (1998);

**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 6, 2004.

Dated: July 6, 2004

  
\_\_\_\_\_  
Mark J. Cohen

4. Wlaz, et al., "Anticonvulsant effects of eliprodil alone or combined with the glycine<sub>B</sub> receptor antagonist L-701,324 or the competitive NMDA antagonist CGP 40116 in the amygdala kindling model in rats", Neuropharmacology, 38: 243-251 (1999); and
5. Ebert, et al., "Anticonvulsant effects by combined treatment with a glycine<sub>B</sub> receptor antagonist and a polyamine site antagonist in amygdala-kindled rats", European Journal of Pharmacology, 322: 179-184 (1997).

These references were cited in a Search Report dated May 12, 2004 received from the European Patent Office. It is to be noted that the Search Report lists eleven (11) items. However, the following items were previously submitted in an Information Disclosure Statement dated December 18, 2002.

United States Patent No. 5,378,729, issued January 3, 1995;

International Publication No. WO 99/43309, published September 2, 1999;

Kohn, et al., "Synthesis and Anticonvulsant Activities of  $\alpha$ -Heterocyclic  $\alpha$ -Acetamido-N-benzylacetamide Derivatives", J. Med. Chem., 36: 3350-3360 (1993);

Andurkar, et al., "The Anticonvulsant Activities of N-Benzyl 3-Methoxypropionamides", Bioorganic & Medicinal Chemistry, 7: 2381-2389 (1999);

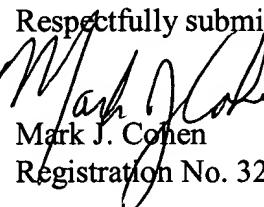
Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C<sup>α</sup>,<sup>α</sup>-diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", Int. J. Peptide Protein Res., 44: 85-95 (1994); and

Billich, et al., "HIV proteinase inhibitors containing 2-aminobenzylstatine as a novel scissile bond replacement: biochemical and pharmacological characterization", Antiviral Research, 25: 215-233 (1994).

Since the latter six citations were previously made of record, it is deemed not necessary to make them of record again or to resubmit copies to the United States Patent and Trademark Office.

Applicant is submitting copies of the above-cited references 1-5, together with a copy of the Search Report. The relevance of the above-identified references has been described in the Search Report.

Further, the undersigned hereby states that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. Therefore, no fee is required.

Respectfully submitted,  
  
Mark J. Cohen  
Registration No. 32,211

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343

MJC:lf



Atty. Docket No.  
13095

Serial No.  
09/938,677

**LIST OF PRIOR ART  
CITED BY APPLICANT**

(Use several sheets if necessary)

Applicant  
Robert H. Harris

Filing Date  
August 24, 2001

Group Art Unit  
1653

**U.S. PATENT DOCUMENTS**

EXAMINER INITIAL*		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (if appropriate)
	AA	5,773,475	6/30/98	Kohn			
	AB	5,654,301	8/5/97	Kohn, et al.			
	AC	5,378,729	1/3/95	Kohn, et al.			

**FOREIGN PATENT DOCUMENTS**

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO
		WO 99/43309	9/2/1999	PCT				

**OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)**

	Kohn H. et al., "Synthesis and anticonvulsant activities of $\alpha$ -heterocyclic $\alpha$ -acetamido-N-benzylacetamide derivatives", <i>Journal of Medicinal Chemistry, United States</i> 29 October 1993, vol. 36, no. 22, pp. 3350-3360
	Andurkar, et al., "The Anticonvulsant Activities of N-Benzyl 3-Methoxypropionamides", <i>Bioorganic &amp; Medicinal Chemistry</i> 7 (1999), pp. 2381-2389
	Toniolo, et al., "A crystal-state, solution and theoretical study of the preferred conformation of linear C. $\alpha,\alpha$ -diphenylglycine derivatives and dipeptides with potential anticonvulsant activity", <i>Int. J. Pept. Protein Res.</i> 44. 1994, 85-95, XP001074241, , Page 85, column 1, paragraph 2, Page 86, column 1; example XIV
	Billich, et al., "HIV proteinase inhibitors containing 2-aminobenzylstatine as a novel scissile bond replacement: biochemical and pharmacological characterization", <i>Antiviral Research</i> 25 (1994) pp. 215-233
	Parsons, et al., "Modulation of NMDA receptors by glycine - introduction to some basic aspects and recent developments", <i>Amino Acids</i> , 14: 207-216 (1998)
	Wlaz, et al., "Anticonvulsant effects of eliprodil alone or combined with the glycine <sub>B</sub> receptor antagonist L-701,324 or the competitive NMDA antagonist CGP 40116 in the amygdala kindling model in rats", <i>Neuropharmacology</i> , 38: 243-251 (1999)
	Ebert, et al., "Anticonvulsant effects by combined treatment with a glycine <sub>B</sub> receptor antagonist and a polyamine site antagonist in amygdala-kindled rats", <i>European Journal of Pharmacology</i> , 322: 179-184 (1997)

EXAMINER

DATE CONSIDERED

\* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.